

## REMARKS

In the Office Action mailed December 14, 2005, the Examiner rejected claims 1, 6-10 and 12-27. Applicants have amended claims 1 and 16 to address minor informalities.

### I. Claim Rejections under 35 U.S.C. 103

The Office Action rejected claims 1, 6-10 and 12-27 under 35 USC 103(a) as being unpatentable over Schneider (U.S. Patent No. 6,502,821). Applicants traverse these rejections.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim again the prior art." *In re Wilson*, 424 F2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...  
The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have

selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

### Traversal

In rejecting claims 1, 6-10 and 12-27, the Office Action reads as follows:

Schneider discloses a structural reinforcing member with internal and external members and expandable foam that foams at temperatures associated with e-coat processes. Schneider does not disclose the specific location of the member or the specific shapes claimed. It would have been obvious to ... use such a structure anywhere on a vehicle that is appropriate and to design the element with appropriate shapes for such use as such is merely a design choice.

Below, Applicants explain how this statement, which represents substantially the entirety of the rejections of the Office Action, is inadequate to establish *prima facie* obviousness again the claims of the present application.

### Claim 1 and its dependents

The Office Action fails to establish *prima facie* obviousness against claim 1 because it fails to show that elements of that claim are in the prior art and fails to provide a proper motivation for maintaining a obviousness rejection.

First, the Office Action fails to establish how the prior art shows "an outer hollow member" and "an internal member slideably mounted within the outer hollow member" along with the other language describing the internal member of claim 1. The Office Action also fails to show how the prior art discloses, "an expandable material material" "between the extremities of the compression reducing arms" of the

"internal member" and "the internal surface of the outer hollow member" along with the other language of claim 1.

Additionally, the Office Action has failed to show how the prior art discloses, "the outer hollow member, the internal member or both ... located between an outer front bumper and a front rail of an automobile." Applicant are mindful that the Office Action asserts that it is obvious to, "use such a structure anywhere on a vehicle that is appropriate and to design the element with appropriate shapes for such use as such is merely a design choice." However, Applicants contend that this conclusory assertion does not relieve the Patent Office of its duty to establish the actual elements of a claim within the prior art or the knowledge of the skilled artisan and to show a particular motivation for combining those elements as recited in the claim.

Applicants also specifically traverse the rejections of claims 12 and 13. In particular, Applicants assert that the Office Action has failed to show how the prior art discloses "expandable material" attached to "extremities of compression reducing arms by push pins" and has additionally failed to show how the prior art discloses those push pins acting "as spacers between the extremities of the compression reducing arms and the outer hollow member" along with the other elements of those claims.

For all of the reasons above, Applicants contend that the Office Action has failed to establish a *prima facie* case of obviousness against claim 1 and its dependents and Applicants respectfully request that those rejections be withdrawn.

#### Claim 16 and its dependents

Applicants traverse the rejections of claim 16 and its dependents for all the reasons that they traverse the rejections of claim 1 and its dependents particularly where claim 16 and its dependents include language similar to claim 1 and its dependents. Applicants additionally traverse the rejection of claim 16 and its dependents because the Office Action has at least failed to show how the prior art discloses, "spacers holding the internal member away from the internal surface of the outer hollow member to allow anticorrosion fluid to contact, substantially an entirety of the internal surface of the outer hollow member ..." along with the other language of claim 16. For this reason, Applicants contend that the Office Action has failed to

establish a prima facie case of obviousness against claim 16 and its dependents and Applicants respectfully request that those rejections be withdrawn.

Claim 16 and its dependents

Applicants traverse the rejections of claim 22 and its dependents for all the reasons that they traverse the rejections of claims 16 and 22 and their dependents particularly where claim 22 and its dependent include language similar to claims 1 and 16 and their dependents.

Moreover, Applicant points out that it would likely be improper to present a final rejection of claims 1, 6-10 and 12-27 on a grounds alternative to that already presented since applicants have not amended claims 1, 6-10 and 12-27 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

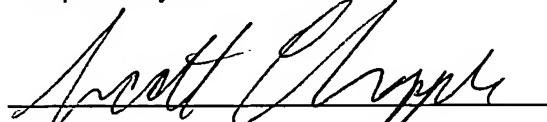
### CONCLUSIONS

In view of Applicants' remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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